

39015-6 (15270.75):JVD:360501

REMARKS

Reconsideration of the present application as amended and in view of the additional discussion below is respectfully requested. Claim 84, 85, and 86 has been amended. Claims 84, 85, and 86 are pending in this application.

This reply is being filed concurrently with a Petition to Revive an Unintentionally Abandoned Application. The Applicant (Illinois Tool Works) recently became owner of this and other applications formerly assigned to Pliant Corp. or Pliant Solutions. Among these properties were numerous applications having non-extendable deadlines in May and early June, 2005, which made it difficult to properly assess the history of each file.

Applicant filed a Request for Continued Examination in the present application, which is evidence of Applicant's intention to keep this application pending. The subsequent abandonment of this file for failure to respond was entirely unintentional. Being filed concurrently with this application is the required Petition and fee for revival.

Applicant is also filing concurrently with this Response and via Express Mail Label No. EV466816081US an Information Disclosure Statement. This IDS includes citation of reissue patent application Serial No. 10/652,572, filed 29 August 2003 (inventor: Provan). Copies of the citation pages of the IDS are enclosed for your reference.

Applicant also brings to the attention of the Examiner the following files that are related to this pending application:

Serial Number 10/290,109, filed 7 November 2002.
Serial Number 10/325,483, filed 19 December 2002.
Serial Number 10/325,596, filed 19 December 2002.
Serial Number 10/405,052, filed 1 April 2003.
Serial Number 11/177,243, filed 8 July 2005.
Serial Number 11/177,226, filed 8 July 2005.

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Objections to the drawings.

Applicant respectfully traverses the Examiner's objection to the drawings under 37 CFR § 1.83(a). Applicant respectfully requests that the Examiner review FIG. 7 and textual support on page 22, beginning at line 20, wherein it is stated that: "Fastener profiles 510 and 520 are substantially identical to fastener profiles 34 and 32 (as shown in FIG. 2), respectively, except that *fastener profiles 510 and 520 are of sufficient length to make a plurality of flexible recloseable containers such as container 20, and have not been attached to a web of flexible plastic film.*" (emphasis added).

The rejections under 35 U.S.C. § 103.

Claim 84 was rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,178,722 to McMahon in view of U.S. Patent No. 5,950,285 to Porchia et al.

In traversal, the Applicant submits that a *prima facie* case of obviousness has not been established because there is no showing of teaching, suggestion or motivation to modify the cited reference in the manner that has been asserted in the Office Action.

To establish a *prima facie* case of obviousness, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Further, the Court of Appeals for the Federal Circuit states that it is "fundamental" that in rejections based on obviousness, there must be "evidence relevant to the finding of whether there is a teaching, motivation, or suggestion to select and combine the references relied on as evidence of obviousness." In re Lee, 61 U.S.P.Q. 2d 1430, 1433 (CAFC 2002). In Lee, the CAFC overturned a rejection by the Board of Patent Appeals and Interferences, stating that the Board's analysis of an invention without showing the

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motivation to combine references “does not comport with either the legal requirements for determination of obviousness or with the requirements of the Administrative Procedure Act that the agency tribunal set forth the findings and explanations needed for reasoned decision making.” Lee @ 1436.

Not only must the obviousness rejection be supported with evidence of teaching, motivation, or suggestion to combine the prior art, those “particular findings must be made . . . with no knowledge of the claimed invention.” Lee @ 1433 (emphasis added). The Court emphasized that “[i]t is improper, in determining whether a person of ordinary skill would have been lead to this combination of references, simply to ‘use that which the inventor taught against its teacher.’” Lee @ 1434 citing W. L. Gore v. Garlock, Inc., 220 U.S.P.Q. 303, 312-313 (CAFC 1983).

With regards to claim 84, the Office Action states that it would have been obvious to fuse together a portion of the fastener strip at a plurality of locations as taught by Porchia into the method of McMahon, and states that the motivation is “to prevent the slider from moving past the ends of the reclosable fastener strip.”

Applicants respectfully assert that this stated motivation does not lead to the proposed combination. The stated motivation of the Office Action is similar to motivations expressed in both McMahon and Porchia. Both McMahon and Porchia show that this motivation leads to a simple, conventional solution, and not the combination proposed in the Office Action.

For example, McMahon refers to sealing the ends of the zipper together “to prevent the slider 54 from becoming detached therefrom (col. 5, lines 46-48); and also that the zipper may be provided with a stopper “to prevent the slider from becoming disengaged from the zipper” (col. 3, lines 65-67). However, McMahon uses this motivation to form only a single cross seal at any one time (col. 5, lines 36-53). Indeed, even though McMahon describes four embodiments (FIGS. 5, 8,

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9, and 10), his stated motivation never leads to anything except a single seal formed at a single time.

With regards to Porchia, his disclosure includes endstop means 30 which "prevent the slider 10 from moving beyond the end of the bag" (col. 5, lines 16-18). However, Porchia's motivation leads only to a completed bag having two endstops (FIG. 1). Porchia does not provide any motivation which would lead to the combination proposed in the Office Action.

In summary, the stated motivation in the Office Action ("to prevent the slider from moving past the ends of the reclosable fastener strip") does not lead to the proposed combination. Both Porchia and McMahan have similar motivations that lead to simple, conventional solutions which are different than the proposed combination. Therefore, the stated motivation in the Office Action leads only to the solutions of Porchia and McMahan, and not to the examined claim, which includes fusing together a portion of the fastener strips at a plurality of locations.

Since the Office Action does not show a suggestion or motivation that leads to the claimed invention, a *prima facie* case of obviousness has not been established. Applicant respectfully request withdrawal of the rejection.

Further, Applicant has amended claim 84 to improve its clarity. Claim 84 includes attaching the interlockable fastener strips to the web of flexible film after fusing together a portion of the fastener strips at a plurality of locations. Applicant respectfully requests allowance of claim 84 and all claims dependent thereon.

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Claim 85 was rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,405,478 to Richardson et al. in view of U.S. Patent No. 5,067,208 to Herrington, Jr. et al.

In traversal, the Applicant submits that a *prima facie* case of obviousness has not been established because there has been shown no proper teaching, suggestion or motivation to modify the cited reference in the manner that has been asserted in the Office Action.

To establish *prima facie* obviousness of a claimed invention, the Patent Office has the initial burden of identifying in the prior art some teaching, suggestion or motivation to modify the cited references. Furthermore, the prior art must be taken only for what it would teach or suggest to a person of ordinary skill in the art at the time of the invention, without using impermissible hindsight.

Claim 85 refers to an apparatus for attachment to a flexible, reclosable bag. Claim 85 includes elements which have not yet been attached to a flexible, reclosable bag. In contrast, Richardson discloses the use of completed bags. Richardson discloses the application and claim bonding of a length of tubing which is positioned on "[B]ag material B including a zipper profile 11 assembled thereon," (col. 4, lines 49-50). Richardson's assembly station is provided "bag material including the zipper profile" (col. 4, lines 51-52; see generally col. 4, line 47 to col. 5, line 15). Richardson starts a bag and a zipper.

Thus, the combination of Richardson and Herrington does not disclose the apparatus of claim 85 which is subsequently attached to a flexible, reclosable bag. Lacking all elements of claim 85, a *prima facie* case of obviousness has not been established. Applicant respectfully requests withdrawal of the rejection of claim 85.

In addition, Applicant has amended claim 85 to refer to an apparatus for subsequent attachment to a flexible reclosable bag having a width. This amendment clarifies claim 85.

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The Office Action of December 9, 2004 rejected claim 86 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,405,478 to Richardson et al. in view of U.S. Patent No. 5,067,208 to Herrington, Jr. et al. and further in view of U.S. Patent No. 4,620,320 to Sullivan.

Applicant has amended claim 86 to remove that "at least a portion of the length of said fastener strips not being attached to the film." Further, Applicant has amended claim 86 to refer to an apparatus for subsequent attachment to flexible film. In contrast, Sullivan discloses a portion of the length of fastener strips that is never attached to the film.

Lacking all elements of claim 86, the cited combination does establish a *prima facie* case of obviousness, and withdrawal of the rejection of claim 86 is requested.

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CLOSING

Applicant respectfully requests examination of pending claims 84, 85, and 86.

It should be understood that the above remarks are not intended to provide an exhaustive basis for patentability or concede any basis for rejections or objections in the Office Action. For those rejections based upon a combination of references, there is no admission that the cited combinations are legally permitted, properly motivated, or operable. Further, with regards to the various statements made in the Office Action concerning any prior art, the teachings of any prior art are to be interpreted under the law. Applicants make no admissions as to any prior art. The remarks herein are provided simply to overcome the rejections and objections made in the Office Action in an expedient fashion.

The undersigned welcomes a telephonic interview with the Examiner if the Examiner believes that such an interview would facilitate resolution of any outstanding issues.

Respectfully submitted

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